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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,869	03/18/2004	Hiraku Murayama	018961-067	5448

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EXAMINER

ROY, ANURADHA

ART UNIT PAPER NUMBER

3736

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/802,869	<b>Applicant(s)</b> MURAYAMA ET AL.	
	<b>Examiner</b> Anuradha Roy	<b>Art Unit</b> 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 15-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/18/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

- I. Claims 1-14, drawn to a guide wire.
- II. Claims 15-25, drawn to method of manufacturing a guide wire.

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, process as claimed can be used to make other and materially different product, such as a catheter.

During a telephone conversation with Ms. Wendy Weinstein on January 31, 2006 a provisional election was made with traverse to prosecute the invention of the Group I (guide wire), claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-25 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Uchino et al. (US Patent No. 6,001,068).

Regarding claims 1, 9, 10, 12, 13, & 14, Uchino et al. discloses a guide wire (Figure 1) comprising a distal end side portion (111) formed of a first metallic material (Column 3, line 54 – Column 4, line 6), a proximal end side portion (131) formed of a second metallic material (Column 4, lines 7-26) higher in rigidity than said first metallic material, and an intermediate portion (proximal end of A, 12, & distal end of B) provided between said distal end side portion and said proximal end side portion and containing said first metallic material (A) and said second metallic material (B), said intermediate portion comprises a gradient physical property portion in which the content of said first metallic material decreases from the distal end side toward the proximal end side, and in which the content of said second metallic material increases from the distal end side toward the proximal end side (Column 4, line 27 – Column 5, line 17), a distal end portion of said intermediate portion is formed only of said first metallic material (proximal end of A), and a proximal end portion of said intermediate portion is formed only of said second metallic material (distal end of B), and said distal end portion of said intermediate portion is joined to said distal end side portion by welding and said

proximal end portion of said intermediate portion is joined to said proximal end side portion by one of welding, soldering or brazing (Column 7, lines 19 – 30).

Regarding claim 2, Uchino et al. discloses a guide wire (Figure 1), wherein the content of said second metallic material in said gradient physical property portion increases stepwise (proximal end of A, 12, & distal end of B) from the distal end side toward the proximal end side. Examiner asserts since there are distinct regions of material, there is an inherent stepwise increase of second metallic material.

With regard to claim 3, Uchino et al. discloses a guide wire (Figure 1), wherein the content of said second metallic material in said gradient physical property portion increases continuously (proximal end of A, 12, & distal end of B) from the distal end side toward the proximal end side. Examiner asserts since there is an increase in the second metallic material within the intermediate section and since the intermediate section is integral, there is an inherent continuous increase of the second metallic material.

In regard to claim 4, Uchino et al. discloses a guide wire (Figure 1), wherein said first metallic material is a Ni--Ti based alloy (Column 3, line 54 – Column 4, line 6).

In regard to claim 5, Uchino et al. discloses a guide wire (Figure 1), wherein said second metallic material is a stainless steel (Column 4, lines 22 - 26).

Regarding claim 6, Uchino et al. discloses a guide wire (Figure 1), which comprises a coil portion (112) so provided as to cover a distal end portion thereof (Figure 1).

With regard to claim 7, Uchino et al. discloses a guide wire (Figure 1), wherein said coil is formed of a contrast material (Column 6, lines 15 - 19).

In regard to claim 8, Uchino et al. discloses a guide wire (Figure 1), wherein at least a portion of an outer surface of said guide wire is coated with a resin (Column 5, lines 63 – 66).

And finally, in regard to claim 11, Uchino et al. discloses a guide wire, which is an integral body free of any joint portion (Figure 1). It has been held that the term "integral" is sufficiently broad to embrace constructions united by such means as fastening and welding. *In re Hotte*, 177 USPQ 326, 328 (CCPA 1973).

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sharrow et al. (US Publication No. 2004/0167437), Fujimoto et al. (US Publication No. 2003/0181828), Okajima (US Patent No. 5,554,139), and Wang (US Patent No. 5,622,665, & 5,533,985) all discloses an intermediate portion with a gradual change between two different materials.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anuradha Roy whose telephone number is (571) 272-6169 and whose email address is anuradha.roy@uspto.gov. The examiner can normally be reached between 8:00am and 4:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's

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supervisor, Max Hindenburg can be reached on 571-272-4726.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

~AR~

  
**MAX F. HINDENBURG**  
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